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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,146

09/08/2003

Xavier Blin

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04/29/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

04/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,146	<b>Applicant(s)</b> BLIN ET AL.	
	<b>Examiner</b> JAMES W. ROGERS	<b>Art Unit</b> 1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/24/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2008 has been entered.

Applicants amendments to the claims filed 03/24/2008 has been entered. Any rejection from the previous office action not addressed in the action below has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,10-13,24-32,36-39,50-65,69-72,83-84,86-94,98-101 and 112-118 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnaud et al. (US 5,961,998, cited previously).

Arnaud teaches glossy compositions, specifically make-up compositions intended for use on the skin and mucous membranes such as the lips. See abstract and

col 1 lin 5-19. The composition contains 5 to 80% by weight of one or more oils with an aromatic group including PDM 1000 and PCR 15M30; as recited within applicants own specification (See [0045] of US 20040126350 A1) these two phenyl-siloxanes meet applicants claimed high viscosity phenylsiloxane. See col 3 lin 14-col 4 lin 44. The compositions also contain an additional type of oil other than the aromatic containing oil including synthetic esters such as diisostearyl malate and triisocetyl citrate, these additional oils can represent 5 to 30% by weight of the composition. See col 5 lin 21-col 6 lin 6. Regarding the proviso that the composition contains no more than 5% of a volatile oil, the composition as recited within Arnaud only uses a non-volatile hydrocarbon solvent, thus the amount of volatile oil is zero. Regarding the limitations that the composition has a post-trial staying power within a certain amount, since the composition of Arnaud comprises the same ingredients as applicants it inherently meets the above limitations because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Additionally the compositions can contain 5 to 30% of various ingredients including waxes that can be silicone based, microcrystalline or synthetic waxes such as polyethylene waxes and

silicone waxes such as alkyl- or alkoxydimethicones having from 16 to 45 carbon atoms. See col 6 lin 30-46. The composition can further comprise 0.5-20% of a particulate phase that includes pigments and/or pearlescent agent and or fillers. See col 4 lin 45- col 5 lin 20. Regarding the limitation that the composition is anhydrous Arnaud clearly states that water can be present in amounts of 0-95% and is clearly optional. See col 6 lin 27-29.

### ***Response to Arguments***

Applicant's arguments filed 03/24/2008 have been fully considered but they are not persuasive. Applicants assert that Arnaud contains an ingredient not present in the claimed composition, a thickener comprising at least one polysaccharide ether, thus applicants surmise since the composition of Arnaud is different in cannot inherently have the claimed post-trial staying power. Applicants further assert that Arnaud does not provide guidance for selecting an oil with a silicone-based skeleton and a non-volatile hydrocarbon oil, thus one skilled in the art would not have at once envisaged the claimed invention from the long list of possible oils within Arnaud.

The relevance of these assertions is unclear. Firstly the transitional term "comprising", which is synonymous with "including", "containing", or "characterized by", is inclusive or open ended and does not exclude additional elements or method steps recited in the prior art. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Thus applicants claims do not preclude additional ingredients from being present within the composition, thus a polysaccharide ether is not excluded from applicants composition. It is also noted by the examiner that

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applicants claim to a hydrocarbon non-volatile oil is not very limiting in that it only requires a MW of over 500 g/mol, a polysaccharide ether is a hydrocarbon oil with a MW more than 500 g/mol, thus it would not seem to be precluded from applicants claims. The burden is shifted to applicants to show evidence that the formulation of Arnaud would not have the same claimed staying power simply because of the thickener comprising polysaccharide ether in the wt% of the composition described. Regarding applicant's assertion that one skilled in the art would not have envisaged their claimed invention from the teachings of Arnaud, the examiner disagrees. Arnaud teaches that the composition contains one or more oils including hydrocarbon-based or silicone based **optionally with fluoro groups**, the silicone oils included phenyl groups within their structure and the hydrocarbon oils included tridecyl trimellitate, both of these types of oils are limitations within the claims of Arnaud, thus they are hardly selected from a long list, rather they are in fact paramount to the claimed invention. Since a phenylsilicone and hydrocarbon oil are claimed applicants claimed invention would have been readily envisaged by one of ordinary skill in the art. The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7,10-33,36-52,54-66,69-84,86-95 and 98-118 are rejected under 35 U.S.C. 102(e) as being anticipated by Agostini et al. (US 2003/0017124 A1, cited previously).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Agostini teaches a two-coat makeup product for the skin, lips or other integuments that contains two compositions. See abstract and [0003]. The second composition includes non-volatile liquids such as hydrocarbon based liquids including diisostearyl malate and high and low viscosity silicone oils that meets applicants claimed high and low viscosity phenylsiloxane. See[0152]-[0202] Regarding the proviso that the composition contains no more than 5% of a volatile oil, the second composition as recited within Agostini only uses a non-volatile solvent, thus it contains essentially no volatile oil. Regarding the limitations that the composition has a post-trial staying power within a certain amount, since the composition of Agostini comprises the same

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ingredients as applicants it inherently meets the above limitation because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The nonvolatile liquid can comprise from 1% to 100%, preferably 5 to 95%, better still from 20 to 80% and better still 40 to 80% of the total composition. The ratio of the low-viscosity and high viscosity phenylsiloxane oil can range from 70/30 to 30/70, better still from 60/40 to 40/60 and better still from 55/45 to 45/55, within applicants claimed ratio. The second composition includes a coloring agent that may also be present in a particulate paste; advantageously the particulate paste is a pigmentary paste. See [0206]-[0242]. The amount of particulate matter within the composition can be from 0.5 to 60, preferably 2 to 40% and most preferably from 3 to 30% of the total composition. The second composition could additionally comprise from 0 to 20% by weight of additives including waxes that are hydrocarbon based, silicone based and/or fluoro based. See [0143] and [0243]-[0248]. Numerous different types of waxes could be selected and include microcrystalline wax, polyethylene wax, silicone waxes made from alkyl, alkoxy and/or esters of polymethylsiloxane, preferably the amount of wax present is from 3 to 25%. Regarding the limitation that the



composition is anhydrous Agostini specifically recites that the second composition is advantageously in anhydrous form. See [0255].

### ***Response to Arguments***

Applicant's arguments filed 03/24/2008 have been fully considered but they are not persuasive. Applicants assert that the post staying power of the product taught by Agostini is not necessarily inherent since the reference requires two compositions to be layered on the other. Applicants further assert that Agostini does not provide any preference for adding a rheological agent to the second composition. Applicants lastly assert that Agostini also teaches that the composition may contain a volatile liquid phase, however the reference does not provide any teaching for limiting the amount of volatile oil.

The relevance of these assertions is unclear. Firstly since the second composition is the same as applicants claimed invention it is inherent that any property of that composition will be the same including its staying power. The fact that the second composition was used in combination on an individual with the first composition is irrelevant to the claimed invention since applicants claims are drawn to a composition not a method of applying a composition to an individual. Regarding applicants assertion that Agostini does not provide any preference to adding a rheological agent to the second composition, the relevance of this assertion is unclear as clearly Agostini teaches that a rheological agent can be added to the second composition. In regards to the second composition containing a volatile liquid phase, clearly this component is optional in the second composition of Agostini, thus its amount can be essentially zero.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998).

Arnaud is disclosed above. Arnaud in addition to describing high viscosity phenylsiloxanes also discloses the use of low viscosity phenyl siloxanes such as DC556. Therefore since Arnaud discloses that either a high viscosity or low viscosity phenylsiloxane can be used as the oil it would have been obvious to one of ordinary skill in the art to combine two phenylsiloxanes; since they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition. Arnaud discloses all of applicants claimed ingredients such as the non-volatile oils, waxes and particulate matter such as pigments, the ranges of the above overlap applicants disclosed range although they are not totally encompassed within applicants disclosed range. It would have been obvious to one of ordinary skill in the art at the time of applicants claimed invention to adjust the concentrations of the ingredients to arrive at the desired form of the cosmetic (solid, gel or liquid) by adjusting the amounts of oil and solid particulate content to arrive at a composition with the desired properties. It is a prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. E.g., In re Geusler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1976); In re Malagari, 449 F.2d 1297, 1202, 182 USPQ 549, 553 (CCPA 1974). It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of

percentages. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) (“[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art.” See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Paterson* Appeal No. 02-1189 (Fed. Cir. January 8, 2003).

### ***Response to Arguments***

Applicant's arguments filed 03/24/2008 have been fully considered but they are not persuasive. Applicants assert that Arnaud does not teach or suggest the claimed post trial staying power and does not provide a basis for modifying the compositions to have such characteristics. Applicants also assert that Arnaud would not have motivated one skilled in the art to select an oil with a silicone-based skeleton and a non-volatile hydrocarbon oil. Lastly applicants assert that Arnaud does not provide motivation to use both a high and low viscosity phenylsiloxane in combination.

The relevance of these assertions is unclear. The remarks above by the examiner are incorporated in their entirety herein for applicant's arguments on the post staying power and selecting an oil with a silicone-based and non-volatile oil. That is from the disclosure of Arnaud one of ordinary skill in the art could have selected applicants ingredients and it is obvious that since the scope of applicants claimed invention overlaps the disclosure of Arnaud the properties of the two compositions will be the same. In response to applicants assertion that there is no motivation to combine both a high and low viscosity phenylsiloxane, motivation is not the only consideration when determining obviousness, the recent court ruling within KSR International Co.

v. Teleflex Inc. (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007), upheld this view of the office. As described in the rejection above it would have been obvious to combine a high and low viscosity phenylsiloxane from the disclosure of Arnaud since they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition.

Claims 1-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998) in view of Willemin et al. (US 6,592,855 B1, cited in previous office action).

Arnaud is disclosed above. Arnaud while disclosing both the use of low and high viscosity phenylsiloxanes is silent on the use of a low and high viscosity phenylsiloxane in combination.

Willemin was cited in the previous office action filed 06/14/2007. Willemin is used primarily for the disclosure within that low viscosity phenylsiloxanes were well known in the art to be useful in cosmetic formulations.

It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the cosmetic formulation disclosed in Arnaud and add the low viscosity phenylsiloxanes disclosed within Willemin. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for

the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components found within a cosmetic formulation. It therefore follows that the instant claims define *prime facie* obvious subject matter.

### ***Response to Arguments***

Applicant's arguments filed 03/24/2008 have been fully considered but they are not persuasive. Applicants assert there would be no motivation to combine the low viscosity phenylsiloxane of Willemin with the composition of Arnaud and the examiners unsupported statement that low viscosity phenylsiloxanes were well known in the art is insufficient to provide motivation. Applicants also reiterate their argument summarized above that Arnaud teaches an additional ingredient which is not present in the claimed composition, thus applicants surmise the resulting composition would not necessarily have the claimed post-trial staying power.

The relevance of these assertions is unclear. Firstly the remarks above by the examiner are incorporated in their entirety herein for applicant's arguments on the post staying power. Secondly as detailed in the rejection above it is generally considered to be *prima facie* obvious to combine two compounds such as the phenylsilicone oils of Arnaud and Willemin in order to form a composition that is to be used for an identical purpose. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of

preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be prima facie obvious.).


### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618

<b>Application Number</b> 	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	10/656,146	BLIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMES W. ROGERS	1618	